

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed June 2, 2003. Claims 1-18 and 25-40 remain pending.

Reconsideration of the application is respectfully requested in view of the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

I. Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 1-18 and 25-40 under 35 U.S.C. § 103(a) as being unpatentable over *Noji* (U.S. Patent No. 4,686,417) in view of *Hatanaka, et al.* (U.S. Patent No. 4,303,572). Applicant respectfully traverses this rejection, on the basis that the references – either individually or in combination – do not teach or suggest the claimed invention.

First, as was explicitly acknowledged by the Examiner in the Office Action, *Noji* does not teach or suggest the use of two or more metal powders. Office Action, page 3. To address this deficiency, the Examiner alleges that *Hatanaka* teaches the use of a plurality of powder metals, which can be “used together depending upon the particular shielding properties desired.” Office Action, page 3. However, a close reading of *Hatanaka* reveals that this is not the case. In fact, *Hatanaka*, like *Noji* fails to teach or suggest the use of two (or more) metal powders in a manner that is required by the present claims.

Hatanaka is generally directed to a curable silicone composition containing “fine powder of a transition metal, such as tungsten or silver.” *Hatanaka* at col. 1, lines 6-7. Throughout the specification, it is emphasized that the curable silicone composition of the invention includes only “fine powder of a [single] transition metal.” *See, e.g.*, col. 2, lines 3-15. Nowhere does the

reference teach or suggest that multiple powder metals be used. Indeed, while *Hatanaka* teaches a number of potential transition metal powders that can be used, it suggests that only one of the powders be selected, depending on the “special properties required for special uses of the cured products.” Col. 3, lines 31-32. For example, it suggests that silver (singular) be used where conductivity is desired, and that tungsten (singular) be used where x-ray shielding “properties” are desired. This use of a single metal powder is further demonstrated in the multiple examples disclosed by *Hatanaka* – none of which illustrate or suggest the use of additional metal powders.

Thus, on this basis alone, it is believed that the Examiner has failed to make a *prima facie* case of obviousness, since the cited references fail to teach each and every limitation of the rejected claims – all of which require the presence of at least a first powder metal and a second powder metal. As such, Applicants respectfully request that the rejection be withdrawn.

In addition, the combination of the cited references is improper for at least one other reason. In particular, there is absolutely no motivation to combine any alleged teachings of *Hatanaka* with those of *Noji*. In particular, *Noji* is directed to an “x-ray image intensifier apparatus.” In contrast, as noted above, *Hatanaka* pertains to composition for providing a curable silicone composition having particular characteristics. For example, *Hatanaka* teaches that the composition can be used to provide a silicone rubber tube. See, column 8, line 23. Clearly, one of skill in the art would not be motivated to combine a technology relating to a “silicone rubber” with that of an x-ray tube environment, which is subject to excessive heats that would melt silicone rubber. As such, it is respectfully suggested that the combination of *Noji* and *Hatanaka* is improper, and that the obviousness rejection be withdrawn on this basis as well.

CONCLUSION

In light of the arguments set forth above, Applicants earnestly believe that they are entitled to a letters patent, and respectfully solicit the Examiner to expedite prosecution of this patent application to issuance. Should the Examiner have any questions, the Examiner is encouraged to telephone the undersigned.

Respectfully submitted,

Date: December 2, 2003

By: 

ERIC L. MASCHOFF
Registration No. 36,596
Customer No. 022913